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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,859	08/29/2003	Alphons A.M.L. Bruekers	PHN 17,536B	9452
24737	7590	02/09/2007	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS			RAO, ANAND SHASHIKANT	
P.O. BOX 3001			ART UNIT	PAPER NUMBER
BRIARCLIFF MANOR, NY 10510			2621	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/651,859	BRUEKERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andy S. Rao	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11/26/06.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 42-67 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 42-67 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: <u>08/06/06</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Amendment***

1. As per the Applicants instructions filed in 11/29/06, claims 1-41 are canceled.
2. Applicant's remarks with respect to claims 42-65 as filed on 11/29/06 have been considered but are moot in view of the new ground(s) of rejection.
3. Applicant's arguments filed with respect to claims 66-67 as filed on 11/29/06 have been fully considered but they are not persuasive.
4. Claims 66-67 remain under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as was set forth in the Office Action of 830/06.
5. The Applicant presents one argument contending the Examiner's rejection of claims 66-67 under 35 U.S.C. 101 as being directed to non-statutory subject matter, as was set forth in the Office Action of 830/06. However, after a careful consideration of the argument presented, the Examiner must respectfully disagree for the reasons that follow, and maintain the rejection.

The Applicant argues that the "record carrier" limitation is statutory because it is "...defined as any machine or manufacture embodiment of a process..." and that the claims 66-67 embody products of the processes as claimed in 42-43, respectively. The Examiner respectfully disagrees. Since there is no reference to the process of claims 42-43 to be found in the independent claims 67-67, the "record carrier" limitation remains non-statutory. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, and magnetic field strength are non-statutory natural phenomena, *O'Reilly*, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth under

35 U.S.C. 101. For instance, a claimed signal is clearly not a “process” under 35 U.S.C. 101 because it is not a series of steps. The other three classes of machine, compositions of matter, and manufactures “relate to structural entities and can be grouped as ‘product’ claims in order to contrast them with process claims.” 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material, Interim Guidelines, Annex IV, Section (c). Additionally, there is nothing in the specification to sufficient support Applicant’s position concerning the “machine or manufacture process of the embodiment...” as all the disclosure mentions is that a “transmission medium” is the record carrier (Specification: page 3, lines 9-11). The Examiner doesn’t not consider a “transmission medium” as an element that is can be produced from a “machine or manufacture process of the embodiment...” which is what would be meet the class requirement above. Accordingly, the rejection is upheld. While any amendment to Specification will be considered, the Applicant is also cautioned against adding new matter.

#### ***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 42-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is noted that independent claims 42, 55, 66, and 43, 56, 67 recite “combining” and “reconverting” steps, respectively, as the last limitations in the claims. However, these limitations fail to claim a practical application that produces a “...useful,

concrete, and tangible result..." as currently recited. See Interim Guidelines, Annex II, Section B(ii)). There is no mention of actually transmitting the composite information across the transmission medium to the companion decoder, and on the decoding system there is no mention of outputting the signal after reconversion. As such amendments to the claims meeting this requirement is needed to overcome this rejection.

***Allowable Subject Matter***

7. Claims 42-65 are directed towards allowable subject matter.

Independent claims 42-43, 55, and 56 recite "...generating first mapping information and a plurality of m sets of prediction filter coefficients, where m is an integer for which holds  $1 \leq m \leq n$ , said first mapping information and m sets of prediction filter coefficients being representative of said n sets of prediction filter coefficients for said n channels, and for generating second mapping information and a plurality of p probability tables, where p is an integer for which holds  $1 \leq p \leq n$ , said second mapping information and p probability tables being representative of said n probability tables for said n channels..." which are features that are not anticipated nor obvious over the art of record. Dependent claims 43-54, and 57-65 are allowed for the same reasons. Accordingly, if claims 42-43 and 55-56 are amended to overcome the rejection under 35 U.S.C. 101, and if twice rejected claims 66-67 are canceled, the application would be placed in a condition for allowance.

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***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy S. Rao whose telephone number is (571)-272-7337. The examiner can normally be reached on Monday-Friday 8 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on (571)-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andy S. Rao  
Primary Examiner  
Art Unit 2621

asr  
February 6, 2007

ANDY RAO  
PRIMARY EXAMINER